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Paper No. 20  
DEB

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**Trademark Trial and Appeal Board**

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Houlihan's Restaurants, Inc.  
v.  
Hooligan's Pub & Oyster Bar, Ltd.

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Opposition No. 110,160  
to application Serial No. 74/680,068  
filed on May 25, 1995

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Arthur H. Seidel and Susan F. Evans of Seidel Gonda Lavorgna & Monaco, P.C. for Houlihan's Restaurants, Inc.

Jefferson F. Scher and Maria T. Giammanco of Carr & Ferrell LLP for Hooligan's Pub & Oyster Bar, Ltd.

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Before Quinn, Hairston and Bucher, Administrative Trademark Judges.

Opinion by Bucher, Administrative Trademark Judge:

An application was filed by Hooligan's Pub & Oyster Bar, Ltd. to register the mark HOOLIGAN'S for "restaurant, bar and lounge services."<sup>1</sup>

Registration has been opposed by Houlihan's Restaurants, Inc. under Section 2(d) of the Trademark Act on the ground that applicant's mark, when applied to applicant's services, so resembles opposer's previously used and registered marks as to be likely to cause confusion, to cause mistake or to deceive.

Opposer has pleaded ownership of the following registered marks:

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<sup>1</sup> Application Serial No. 74/680,068, filed May 25, 1995, alleging first use on May 1, 1987.

HOULIHAN'S for "restaurant and bar services"<sup>2</sup>; HOULIHAN'S for "prepared entrees consisting primarily of meat, fish, poultry or vegetables; prepared appetizers consisting primarily of meat, fish, poultry or vegetables; soups, garden salads, vegetable salads"<sup>3</sup>; HOULIHAN'S for "ladies' and men's casual clothing and sportswear, namely, shirts, pants, sweaters, sweatshirts and sweatpants"<sup>4</sup>; and



for "restaurant and bar services"<sup>5</sup>:

Applicant, in its answer, denied the salient allegations of the opposition.

The record consists of the pleadings; the file of the involved application; trial testimony, with related exhibits, taken by opposer; and applicant's responses to opposer's interrogatories as well as an entry from a slang dictionary, all introduced by way of opposer's notice of reliance. Applicant neither took testimony nor introduced any other evidence. Both

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<sup>2</sup> Reg. No. 1,835,780, issued on May 10, 1994; Records of the U.S. PTO also show that a §8 affidavit has been accepted and a §15 affidavit has been acknowledged.

<sup>3</sup> Reg. No. 2,018,664, issued on November 26, 1996.

<sup>4</sup> Reg. No. 1,675,147, issued on February 11, 1992; Records of the U.S. PTO also show that a §8 affidavit accepted and a §15 affidavit acknowledged.

<sup>5</sup> Reg. No. 1,984,915, issued on July 9, 1996.

opposer and applicant filed main briefs on the case and opposer filed a reply brief. An oral hearing was not requested.

Opposer, according to Susan Hamilton, opposer's manager of legal affairs, operates 106 restaurants in 24 states, Mexico and Puerto Rico, and has specific plans to expand its market into 22 additional states. While some restaurants are company owned and the balance are franchisees, all are operated in much the same way. The HOULIHAN'S name appears on restaurant signs, on menus, in advertisements, as well as in telephone book listings, restaurant guides and other promotional materials. The HOULIHAN'S name is also used in connection with various promotional materials from wineglasses and mugs to an array of clothing items.

Applicant currently operates three HOOLIGAN'S restaurants in Miami, Florida, and licenses the mark for use in connection with restaurant services in other Southeastern and Mid-Atlantic States.

Before turning to the merits of the likelihood of confusion claim, we direct our attention to a few preliminary matters.

The first relates to newly raised claims in applicant's brief that opposer is not entitled to rely upon the registrations introduced during the testimony of Ms. Hamilton, and that we should exclude her testimony as to first use of opposer's HOULIHAN'S mark on grounds of hearsay and inadequate foundation.

Applicant alleges that opposer has failed to follow the rules for offering evidence sufficient to establish that the registrations are still subsisting. Opposer, as plaintiff in this proceeding, did not submit with the notice of opposition status and title copies of the registrations prepared and issued by the PTO.<sup>6</sup> Rather, opposer relied upon photocopies of its original certificates of registrations introduced during the testimony of Ms. Hamilton.<sup>7</sup> However, applicant points to a defect in opposer's attempt to make these registrations of record:

... Ms. Hamilton authenticated a purported photocopy of this and other certificates of registration as "business records." Ms. Hamilton never testified as to the status of those registrations... Accordingly, the Opposer cannot rely on Registration No. 1,835,780 (or its other registrations) to establish priority of use in this proceeding. (applicant's appeal brief, p. 2).

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<sup>6</sup> Registrations. (1) A registration of the opposer or petitioner pleaded in an opposition or petition to cancel will be received in evidence and made part of the record if the opposition or petition is accompanied by two copies (originals or photocopies) of the registration prepared and issued by the Patent and Trademark Office showing both the current status of and current title to the registration... [37 C.F.R. §2.122(d)(1)].

<sup>7</sup> Registrations. (2) A registration owned by any party to a proceeding may be made of record in the proceeding by that party by appropriate identification and introduction during the taking of testimony or by filing a notice of reliance, which shall be accompanied by a copy (original or photocopy) of the registration prepared and issued by the Patent and Trademark Office showing both the current status of and current title to the registration. The notice of reliance shall be filed during the testimony period of the party that files the notice. [37 C.F.R. §2.122(d)(2)].

We agree with applicant that these registrations were not properly made of record. Contrary to opposer's assertion in its reply brief on appeal, the copies accompanying Ms. Hamilton's testimony (Exhibit 2 for Reg. No. 1,835,780; Exhibit 12 for Reg. No. 2,018,664; Exhibit 13 for Reg. No. 1,675,147; and Exhibit 15 for Reg. No. 1,984,915) are not, "in fact, status and title copies, as is apparent from the exhibits ... " (opposer's reply brief, p. 9). Status and title copies are an official acknowledgment by the Office as to what the Office's records show with respect to a particular registration as of the time of the mailing of the copies to the party in a time frame contemporaneous with their production in the Office proceeding. However, in this case, there is no indication that these photocopies of the pleaded registrations have been *prepared* and *issued* by the Patent and Trademark Office as required by Rule 2.122(d)(2). Rather, the relevant registration documents are merely photocopies of the registrations as issued. The fact that opposer's copies of these registration shows that they originally issued to opposer on May 10, 1994, November 26, 1996, February 11, 1992 and July 9, 1996, respectively, does not establish that title thereto still resided in opposer at the time of filing of the notice of opposition on April 30, 1998, or that they were still valid and subsisting as of that date. Peters Sportswear Co., Inc. v. Peter's Bag Corporation, 187 USPQ 647 (TTAB 1975). Because opposer did not submit official status and title copies

whereon the Patent and Trademark Office had entered data as of a contemporaneous date, these registration copies are insufficient in and of themselves to establish a *prima facie* case of ownership on behalf of the opposer. See Hollister Incorporated v. Downey, 565 F.2d 1208, 196 USPQ 118 (CCPA 1977); Industrial Adhesive Company v. Borden, Inc., 218 USPQ 945 (TTAB 1983); A.R.A. Manufacturing Company v. The Equipment Company, Inc., 183 USPQ 558 (TTAB 1974); and Maybelline Company v. Matney, 194 USPQ 438 (TTAB 1977); See also TBMP §703.02(a).

Furthermore, after introducing the copies of the original certificates of registration during the taking of the testimony of Ms. Hamilton, opposer failed to elicit any testimony from her with respect to the status and title of these registrations at the time of her testimony. Thus, opposer has failed to establish that it is the current owner of the pleaded registrations, or that they are alive and subsisting. See Maybelline Company v. Matney, *supra*.<sup>8</sup>

The second objection applicant makes in its main brief is that Ms. Hamilton's testimony as to opposer's first use of the HOULIHAN'S mark in 1972 should be disregarded on grounds of hearsay and inadequate foundation:

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<sup>8</sup> Opposer's counsel had Ms. Hamilton clarify later in her testimony that the two older registrations that had originally issued to Gilbert/Robinson, Inc., had since been assigned to opposer due to a name change, arguably showing title with opposer at some prior date. However, this did not cure the failure to elicit testimony on the extant status of any of the four claimed properties.

In her deposition, Ms. Hamilton testified that she was first employed by the Opposer on March 15, 1993. [page cites omitted] Accordingly, Ms. Hamilton cannot have personal knowledge of this fact [date of first use]. Her testimony was "I believe the first Houlihan's opened April 15<sup>th</sup>, 1972." No basis is supplied for this belief, no records cited, no foundation established at Ms. Hamilton's deposition... The Board should disregard Ms. Hamilton's testimony as lacking foundation and/or hearsay. (appeal brief p. 1).

In response, opposer cites to the relevant section of the Federal Rules of Civil Procedure dealing with the effect of errors in depositions, arguing that this was a defect that could have been easily remedied had it been raised at the time of the deposition.<sup>9</sup>

On this point, we agree with opposer that the final clause of Rule 32(d)(3)(A) applies to the situation at hand. In this case, had opposer's counsel been faced with this challenge at the time of the deposition, he could have elicited more information from Ms. Hamilton about how her job duties and years of experience had permitted her to acquire her personal knowledge of relevant facts to which she was testifying. Accordingly, we find that applicant's objection to Ms. Hamilton's testimony on grounds of hearsay and inadequate foundation has been waived.

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<sup>9</sup> Fed. R. Civ. Pro. 32(d)(3) As to Taking of Deposition. (A) Objections to the competency of a witness or to the competency, relevancy, or materiality of testimony are not waived by failure to make them before or during the taking of the deposition, unless the ground of the objection is one which might have been obviated or removed if presented at that time.

With these procedural decisions in mind, we turn our attention first to the issue of priority. Without reliance on the federal registrations, we turn to Ms. Hamilton's testimony. Although Ms. Hamilton was not hired by opposer until 1993, her duties as opposer's manager of legal affairs included the maintenance of the company's trademark records. We should add, however, that the written transcript of her brief testimony on the dates of first use makes her appear to be somewhat tentative.<sup>10</sup> Nonetheless, we have deemed her competent to testify to the dates on which opposer first used the HOULIHAN'S name, and find the totality of her testimony probative enough to establish opposer's common law rights in the HOULIHAN'S service mark as of 1973. This clearly precedes any date on which applicant can rely, and hence, we find that the record shows opposer to be the prior user. Accordingly, inasmuch as opposer has established its priority, the only question to be determined herein is whether the contemporaneous marketing of the respective services of the applicant and the opposer under the designations here involved is likely to cause confusion or to cause mistake or to deceive. TE Automatic Electric Incorporated v. Merit International Corp., 196 USPQ 263 (TTAB 1977).

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<sup>10</sup> Her statement about opposer's first use date began with the phrase, "I believe ... " (p. 9). Then several times she misstates the first date of use anywhere as 1992, before correcting herself each time to 1972. On the date of first use in commerce of the HOULIHAN'S mark, after coaching, she appears to read the year 1973 from the face of the document (p. 15).



Hence, we turn our attention to the issue of likelihood of confusion. Our determination under Section 2(d) is based upon an analysis of all of the facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). The factors deemed pertinent in this proceeding now before us are discussed below.

Turning first to the services, it appears as if the services are identical in the case of restaurant and bar services. Thus, we must presume that applicant and opposer are entitled to offer their services in all normal trade channels for such services, and to all normal classes of customers for such services. See In re Elbaum, 211 USPQ 639 (TTAB 1981). In any case, the probative evidence placed in the record by opposer merely confirms that the services offered under these respective marks are actually quite similar.

Furthermore, as to the du Pont factor focusing on the conditions under which and buyers to whom sales are made, nothing in this record persuades us that purchasers of restaurant and bar services are necessarily sophisticated purchasers who would be immune to source confusion when faced with similar marks used on the identical services involved in this case. See In re Continental Graphics Corp., 52 USPQ2d 1374 (TTAB 1999), and Refreshment Machinery Incorporated v. Reed Industries, Inc., 196 USPQ 840 (TTAB 1977). To the contrary, these services are

relatively inexpensive, and are sold to members of the general public rather than to sophisticated purchasers. As a result, the purchase of these services would not be the subject of a great deal of thought or analysis.

With these points in mind, we turn to a consideration of the parties' marks, keeping in mind as well that "when marks would appear on virtually identical goods or services, the degree of similarity necessary to support a conclusion of likely confusion declines." See Century 21 Real Estate Corp. v. Century Life of America, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992).

The marks are similar in appearance. Both marks have nine letters. Of these nine letters, seven are identical. The small changes in the third and sixth letters in applicant's mark do not serve to visually distinguish the marks in any meaningful way.

Additionally, when spoken, the three-syllable word HOOLIGAN'S sounds quite similar to the three-syllable word HOULIHAN'S. The first syllables of the marks begin with prefixes that sound identical, "HOO-" and "HOU-." The second syllables are identical in every way, "-LI-." In fact, both parties use their respective first two syllables ("HOULI" and "HOOLI") in shortened forms for things from a cartoon character to menu items. Granted, the final syllables of the marks ("-GAN" and "-HAN") have somewhat different pronunciations. However, we find that in the context of the sound of the two marks in their

entireties, they certainly do not have radically different pronunciations.

In its strongest argument for finding the marks to be dissimilar, applicant contends that confusion is not likely because "hooligan" is a dictionary word meaning "young ruffian" or "hoodlum," and thus prospective customers will perceive a difference between applicant's mark and the surname, HOULIHAN'S. While the word "hooligan" does have a distinct dictionary meaning, opposer points out that applicant has adopted the possessive form of the word (HOOLIGAN'S). Hence, even on the connotation prong of the trilogy, when presented in this form, the mark is reminiscent of a surname and conveys a surname image as does opposer's name. Accordingly, we find that when considered in their entireties, as they must be, the marks HOULIHAN'S and HOOLIGAN'S are sufficiently similar in overall commercial impression, that when used in connection with identical services, consumers are likely to be confused as to source. Furthermore, it is well recognized that purchasers are not infallible in their recollection of marks and often retain only a general or overall impression of the marks. See Grandpa Pidgeon's of Missouri, Inc. v. Borgsmiller, 477 F.2d 586, 177 USPQ 573 (CCPA 1973); and Interco Inc. v. Acme Boot Company, Inc., 181 USPQ 664 (TTAB 1974).

Opposer contends that its mark is well known and strong. Indeed, the record reflects that the 106 restaurants trading

under the HOULIHAN'S name enjoyed gross revenues of \$172 million in the year 1998 alone. Accordingly, we find that opposer has enjoyed success with the restaurant and bar services offered under the HOULIHAN'S name. Further, the record is devoid of evidence of any current third-party uses or registrations of similar marks for restaurant and bar services. Although we are willing to accept the claim that its mark is well known and strong in the trade, based upon the current record, we do not accord the status of "famous" to the HOULIHAN'S service mark. Cf. Kenner Parker Toys v. Rose Art Industries, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992).

With regard to applicant's assertion that neither party is aware of any instances of actual confusion occurring as a result of the contemporaneous use of the marks of applicant and opposer, the record is fairly sparse as to the extent of promotion and use of applicant's service mark. Nonetheless, we note that applicant's use has been limited to the Southeastern and Mid-Atlantic States, a region of the country where opposer has located few restaurants to date. Thus, given minimal geographic overlap, the opportunity for instances of confusion has been low. More importantly, evidence of actual confusion is notoriously difficult to obtain, particularly in the case of generally inexpensive goods or services. See Helene Curtis Industries Inc. v. Suave Shoe Corp., 13 USPQ2d 1618, 1623 (TTAB 1989). In any event, the test under Section 2(d) of the Trademark Act is

likelihood of confusion rather than actual confusion. See Block Drug Co. v. Den-Mat Inc., 17 USPQ2d 1315, 1318 (TTAB 1989).

Finally, if we are left with any doubt as to the likelihood of confusion, such doubt must be resolved in favor of the prior user and registrant, and against the newcomer, who has a duty to select a mark which is not likely to cause confusion with trademarks already in use. Burroughs-Wellcome Co. v. Warner-Lambert Co., 203 USPQ 191 (TTAB 1979).

Decision: The opposition is sustained.